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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

09/803,208

03/09/2001

Toshiyuki Moritsu

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08/23/2006

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.  
1800 DIAGONAL ROAD  
SUITE 370  
ALEXANDRIA, VA 22314

EXAMINER

KESACK, DANIEL

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,208

Applicant(s)

MORITSU ET AL.

Examiner

Dan Kesack

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 5/30/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,7-16,18-22 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7-16,18-22 and 33-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Amendment filed May 30, 2006 has been entered and fully considered. Currently amended claims 1, 2, 7-9, 12, 14, 16, 18-22, original claims 10, 11, 13, 15, and new claims 33-36 are currently pending. Claims 3-6, 17, and 23-32 have been cancelled. The rejections are as stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 34 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 34 and 36 recite "a date of said electronic data relating to a payment intention." It is unclear how the "date" is related to the "electronic data". The claim is unclear as to the establishment of the date, which is regarded as an essential element of the claimed invention. Furthermore, the claims omit essential steps because in the case where the date of the electronic data has passed the payment due date or

payment period, or in the case where the date of the electronic data has not passed the payment date, it is unclear how the requesting step is completed.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1, 2, 7-10, 18, 20, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Anderson, U.S. Patent No. 6,021,202.

Claims 1, 2, 7, Anderson discloses a method and system for processing electronic transfer of funds between accounts, comprising sending electronic data relating to a payment intention from a payment mediation system to a recipient system (figure 15, banking network) belonging to the funds recipient, when a funds payment intention is received from the payer (column 23 lines 41-45 and 50-56), and requesting a deposit of funds from assets held by said payer into a deposit account of a bank (funds transfer), said deposit account being identified by the recipient system and provided to the payment mediation system upon receipt of the payment intention from

the payment mediation system, and requesting the deposit of funds into said deposit account (column 24 lines 1-10), when electronic data relating to a deposit account is received from said recipient system within a payment period determined from said electronic data relating to the payment intention (column 23 lines 60-63).

Claim 8, Anderson teaches receiving electronic data relating to the deposit account identification and for sending to the financial system belonging to the financial institution electronic data used to check for the existence of a recipient deposit account (column 24 lines 1-10).

Claim 9, Anderson teaches receiving electronic data from the financial institution indicating existence of the deposit account, and beginning processing (column 24 lines 11-24).

Claim 10, Anderson teaches the electronic data including the payment amount, payment date, payer ID, and recipient ID (column 11 lines 32-38).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3624

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 11-16 are rejected under U.S.C. 103(a) as being unpatentable over

Anderson as applied to claim 7 above, and further in view of Smorodinsky, U.S. Patent No. 6,049,786.

Claims 11-16, Anderson fails to teach the use of hash values in the encryption of digitally signed transmissions, storing transactions, along with their hash values, in a database, deciphering incoming transmissions, and verifying their authenticity by comparing extracted hash values with known values from the database.

Smorodinsky discloses an electronic bill payment system employing hashes and digital signatures, a biller computer having a database which stores a plurality of complete bills and a respective hash which is digitally signed, decrypting digitally signed hashes and comparing them with new hashes to determine whether or not the transmission is authentic (column 2 lines 40-67). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of

Anderson to include the hash and digital signature features of Smorodinsky because Anderson teaches the use of hashes and digital signatures as a security feature (column 13 lines 60-67), and the specific implementation of Smorodinsky would provides the security intended by Anderson.

9. Claims 18, 20-22, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson, as applied to claim 7 above, and further in view of Chang, U.S. Patent No. 5,884,288.

Anderson fails to teach sending notification to the recipient system indicating arrival of the payment intention, registering the deposit account and information indicating that funds are unpaid in the payment status field, searching the database for a deposit account associated with the payment status indicating funds are unpaid, changing the payment status to paid when funds have been transferred, and changing the payment status to past due when no payment is received by a due date.

The Chang reference has been fully discussed in the previous Office Action, however the relevant citations for the current rejections are repeated below. Claims 18, 20, and 21, Chang teaches the intermediary sends notification of the pending payment instruction data to the payee (column 7 lines 25-30). Furthermore, Chang inherently teaches the system changes the status to paid when transactions have been completed (column 6 lines 56-61). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Anderson to include the

billing related features as taught by Chang because Anderson teaches the funds transfer system being used to pay bills and invoices, which inherently have due dates (Anderson, column 23 lines 31-36).

Claim 22, the combination of Anderson and Chang fails to teach changing the payment status to past due when no payment has been made within the payment period or by the payment due date. In the previous Office Action, Examiner took Official Notice of this feature, noting that the feature was old and well known in the art. Since Applicant did not adequately traverse Examiner's Official Notice, the common knowledge or well known in the art statement is taken to be admitted prior art. See MPEP 2144.03(C). Thus, it would be obvious to modify the teachings of Anderson and Chang to include this step because it is vital to a financial obligation that both the payor and payee of a transaction be aware of past due obligations.

Claims 34, 36, in light of the rejection under 35 U.S.C 112, second paragraph, above, for the purposes of examination, Examiner has interpreted claims 34 and 36 to involve the establishment of a future date on which to process the transaction. Chang teaches viewing outstanding bills and due dates, and authorizing future payment of specified bills (column 8 lines 39-51). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Anderson to include the scheduling of future payments because it provides a user with additional convenience and ease of use, which are desirable features of Anderson.



10. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson and Chang, in view of Yu et al., U.S. Patent No. 6,067,621.

Claim 19, the combination of Anderson and Chang fails to teach transmitting data to an IC card for authentication, and deleting the data before the IC card is removed. Yu discloses a user authentication system for authenticating an authorized user of an IC card, for the purpose of a secure financial transaction, transmitting an access key to the IC card for user authentication, and deleting the information before the card is removed (column 9 lines 35-53). It would be obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Chang to include Yu's teachings of user authentication using an IC card because Chang teaches that the electronic transactions that are transmitted utilize a digital signal and certification protocol, and any of the well known digital signature and certification protocols can be used (column 7 lines 63-66).

11. Claims 33 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson.

Anderson fails to teach the use of user IDs and passwords for use by senders and recipients of funds in the system. Official Notice is taken that the use of passwords and user IDs, especially in secure financial environments, is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Anderson to include requiring user IDs

and passwords from a payer, when establishing a payment intention, and from a payee when receiving the electronic funds, because the increased security provided by these features is desirable in any financial environment.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1, 2, 7-16, and 18-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

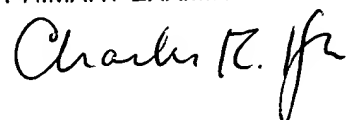
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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CHARLES R. KYLE  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read "Charles R. Kyle", written over the printed name.